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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,065	10/29/2003	David S. Benco	LUTZ 2 00247	5948

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EXAMINER

ISSING, GREGORY C

ART UNIT	PAPER NUMBER
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3662

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/696,065

Applicant(s)

BENCO ET AL.

Examiner

Gregory C. Issing

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20031029.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 22-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The system claims of claims 22-29 are dependent on a method claim 19. It is not clear how the system claims are used to describe the steps of the method. It appears as though claims 22-29 should be correctly dependent upon claim 21.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 10-25, and 28-36 are rejected under 35 U.S.C. 102(a) as being anticipated by Sheha et al.

5. Sheha et al disclose a system and method for providing real-time position of a caller to a called party or of a called party to the caller. The caller and the called party communicate via telephones with a telephone network. The conventional Caller-ID message is adopted to include positional information. The positional information may be derived from an on-board positioning device such as GPS or by using a network positioning approach using the network wireless stations. The position information that is provided to the respective party may include any of geographical mapping information, longitude/latitude information, and address information. In

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view of the embodiment that utilizes GPS and address, it is inherent that the positional information derived from the GPS is converted from the coordinate data to address or mapping information. The ODAS (on-line database and application server) verifies authentication and authorization protocols and correlates the telephone number identification data to update the position database.

6. Claims 1-36 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Russell et al.

Russell et al disclose the claimed method and system for providing location information of a called party to the calling party, see Figures 2 and 3.

7. Claims 1-5, 10-25, and 28-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Brisebois et al.

Brisebois et al disclose a system and method, Figs 2 and 3, for providing dynamic information to called and calling parties indicating the context of a communication event. The context information may be location information, see [0018]. The network can match GPS data to a location translation table.

8. Claims 1-10, 12, 14, 21-29, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Larkins et al.

Larkins et al disclose the claimed method and system for providing called party location information to the calling party, see Figure. A geographic location provider uses GPS, triangulation, distance delay or signal strength methods to locate the called party. A service platform receives a request from an originating unit so as to initiate a program which locates the

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mobile unit being called, the geographic location provider determines the mobile unit, couples it to the service platform which subsequently transmits it to the originating unit.

9. Claims 1-36 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Crowson et al.

Crowson et al disclose the claimed method and system; see paragraphs [0020] – [0024] for operational parameters and Figure 4 and its description at par. [0031] – [0037] for the embodiment of a separate requester other than a PSAP.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chern and Loomis et al disclose databases wherein GPS latitude and longitude information is transformed into useable human /audible readable formats.

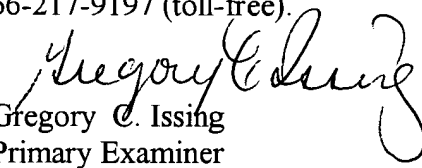
11. Note: all of the claims in the instant application are not directed to a single invention. If the applicants pursue separate lines of demarcation of patentability between the multiple inventions, a restriction may be required. Independent claims 1 and 21 are directed to a method and system for providing location information of a called party to the calling party on the basis of the extracted information. Claim 33 is directed solely to a system for receiving coordinate data, converting the coordinate data to another form and transmitting the converted data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (703)-306-4156. The examiner can normally be reached on Mon-Thurs 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (703)-306-4171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gregory C. Issing
Primary Examiner
Art Unit 3662

gci